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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PRAMIL S.R.L. (ESAPHARMA) Petitioner, v. MICHEL FARAH, Registrant.	Cancellation No. 32,341

PETITIONER'S OPPOSITION TO REGISTRANT'S MOTION TO TAKE ORAL DEPOSITION

Petitioner, through counsel, hereby respectfully opposes the Motion recently filed by the Registrant requesting that the Board order that the deposition of the Petitioner be taken by oral examination and not by written questions. Petitioner is an Italian company and has no immediate plans for a representative to be in the United States within the discovery period.

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Generally, if a testimony deposition is taken in a foreign country, it is taken by deposition upon written questions, rather than by oral examination. Trademark Rule 2.123(a)(2). Also see TBMP §404.03(c)(1).

This is the normal manner in obtaining discovery in situations similar to the ones in this case. It is only in exceptional circumstances and upon a motion for good cause, that the Board will order that the deposition be taken orally. It is not believed that Registrant, in its motion demonstrated why a deposition upon written questions would not be satisfactory under the facts and circumstances of this particular case. The total costs and time involved in conducting a deposition in Italy would far outweigh any inconvenience that the procedures for written questions would entail.

Registrant infers the obvious, that "face-to face oral depositions" are preferable. The issues in this case are no different from the issues in many *inter parte* proceedings before this Board. The allegation that Petitioner would be

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able to review and prepare answers to the specific questions with the assistance of its attorneys is of course true in all discovery upon written questions and is one of the obvious deficiencies in such discovery mode; however, the Rules clearly specify that mode for foreign entities, absent a showing of good cause. Such good cause is absent here.

Certainly, "good cause" must be determined on a case-by-case basis and all of the equities must be weighed, including the obvious advantages of oral depositions and any financial hardships that the party to be deposed might suffer. See the basic rule in *Orion Group Inc. v. The Orion Insurance Co. P.L.C.*, 12 USPQ 2d 1923. In that case good cause was shown, however the issues turned on a Summary Judgment Motion and an Affidavit that raised certain factual and legal issues. See *Feed Flavors Incorporated v. Kemin Industries, Inc.*, 209 USPQ 589 (TTAB 1980).

Clearly, if a party were located in Mexico or Canada, oral depositions would more likely be ordered than if the party were half the way around the world as in this case.

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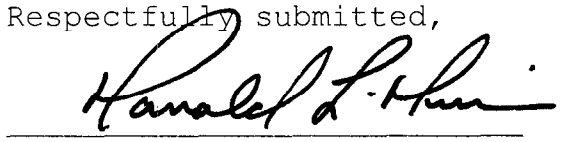
Accordingly, it is Petitioner's position that Registrant has not shown adequate good cause in support of its Motion which should be denied.

Respectfully submitted,



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CERTIFICATE OF SERVICE

I certify that a copy of the foregoing Petitioner's Opposition to Registrant's Motion to Take Oral Depositions Abroad was mailed with proper first class postage affixed to counsel for Registrant, John Cyril Malloy, III, Esq., c/o Malloy & Malloy, P.A., 2800 S.W. Third Avenue, Miami, FL 33129 this 16th day of January, 2002.

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